



JUN 19 2006 Doc Code: AP.PRE.REQ

PTO/SB/SS (07-05)

Approved for use through xx/xx/200x. OMB 0651-00XX
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
31083.05US4

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on June 16, 2006

Signature Ranni Matar

Typed or printed name Ranni Matar

Application Number
09/867,301

Filed
05/29/2001

First Named Inventor
Robert H. Scheer

Art Unit
3627

Examiner
Jasmin, Lynda C.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number 35,906

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Gary R. Jarosik

Typed or printed name

(312) 456-8449

Telephone number

June 16, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

American LegalNet, Inc.
www.USCourtForms.com

REASONS FOR REVIEW REQUEST

In the application claims 1, 4-18, and 20-45 remain pending and presently stand rejected as allegedly being rendered obvious under 35 U.S.C. § 103 over Abdel-Malek (U.S. Patent No. 6,959,235) in view of Yang (U.S. Publication No. 2001/0034673).

It is respectfully submitted that, **with respect to every claim pending**, the burden is on the Office, when attempting to present a *prima facie* case of obviousness, to at least: a) allege that the references being relied upon teach or suggest all of the claimed elements; and b) allege that there exists some suggestion or motivation to combine elements selected from the references to thereby arrive at the invention that is set forth in the claims. *See* MPEP § 2142. As concerns the combining of elements from the references, the Office has the additional burden of particularly explaining why a relied upon combination of elements is proper. To this end, a rejection of the claims must, at the very least, provide a rational explanation as to why and how one of ordinary skill in the art would have combined the elements to arrive at the invention that is set forth within the claims. *See* MPEP § 706.02(j) and *In re Lee* 277 F.3d 1338, 1343-46 (Fed. Cir. 2002).

Considering now the rejection of the claims, it is respectfully submitted that the rejection of the claims fails to meet these burdens for the reason that the rejection of the claims fails to allege that all of the elements set forth in the *independent* claims may be found in Abdel-Malek or Yang (whether considered alone or in combination). Leaving aside the fact that the elements within the dependent claims have never been addressed by the Examiner, it is respectfully noted that the rejection of the claims never alleges that Abdel-Malek, Yang, *or even Abdel-Malek as modified by Yang* includes the expressly claimed element of causing a network of intelligent agents to move items to respective ones of a plurality of geographic locations within a supply chain as a function of a probability that one or more items specified in an advance demand notice

will be needed to be used during performance of a scheduled maintenance work order. Rather, the rejection ignores at least this expressly claimed element and merely concludes that the claims are obvious for the alleged reason that it would have been obvious to modify Abdel-Malek according to Yang to thereby arrive at a system that *generally* includes a network of intelligent agents to fulfill service parts between one or more customer locations. By failing, however, to even allege that all of the elements set forth within the independent claims may be found in the references being relied upon *even when combined*, it is evident that the rejection of the claims has impermissibly distilled the claimed invention down to its “gist” or “thrust,” i.e., the claims were distilled down to a system that *generally* uses a network of intelligent agents to fulfill service parts between customer locations while ignoring at least the claimed moving of the items to locations within a supply chain as a function of a probability that the items will be needed to be used during performance of a scheduled maintenance work order. Since this form of rejection cannot be said to present a *prima facie* case of obviousness under 35 U.S.C. § 103 it is respectfully submitted that the rejection of the claims under 35 U.S.C. § 103 must be withdrawn.

See MPEP § 2143.03.

It is further respectfully submitted that the rejection of the claims has impermissibly failed to consider all of the elements set forth within the claims for the simple reason that neither Abdel-Malek nor Yang discloses, teaches, or suggests at least the aforementioned, expressly claimed element.

That Abdel-Malek fails to disclose the aforementioned, expressly claimed element has been acknowledged in the rejection of the claims. In addition, it is respectfully noted that, rather than disclose that which is claimed, Abdel-Malek discloses a system in which items are moved to a repair facility merely as a function of an item specified in a scheduled work order being

stocked at the repair facility at a level below a predetermined inventory threshold. (Col. 10, lines 26-41).

As for Yang, it is respectfully noted that, when Yang is considered in its entirety as is required, nothing from within Yang can be said to disclose, teach, or suggest the aforementioned, expressly claimed element. Rather, Yang discloses the desirability of using a long term forecast to anticipate needs for parts to thereby establish inventory thresholds at various nodes within a supply chain in hopes of avoiding excess inventories of certain parts and no availability of others. Rather than disclose, teach, or suggest a responsive system such as the one that is expressly claimed, the methodology disclosed within Yang is utilized before even a suggestion of a specific need for a part exists. Thus, like Abdel-Malek, Yang also fails to disclose, teach, or suggest the desirability of moving items to respective ones of a plurality of geographic locations within a supply chain as a function of a probability that one or more items specified in an advance demand notice will be needed to be used during performance of a scheduled maintenance work order.

For at least the reason that the references fail to disclose, teach, or suggest at least the aforementioned, expressly claimed element, it is submitted that the rejection fails to present a *prima facie* case of obviousness and must be withdrawn.

Similarly, the rejection fails to present a *prima facie* case of obviousness as concerns the *dependent* claims since the rejection never asserts that the elements set forth within these claims may be found in either Abdel-Malek or Yang (which they cannot). For example, it has never been asserted that the references disclose the elements set forth within claim 4 (e.g., modifying an existing advance demand notice), claim 6 (e.g., coordinating with a carrier via a computer network to move the items), claims 7-9 (e.g., using the intelligent agents to form a fulfillment plan and forming an alternative fulfillment plan if needed), claims 10 and 11 (e.g., from a

supplier initiating the staging of the items or replenishing moved items), claim 12 (e.g., using a customer defined level of service), claim 13 (e.g., converting an advance demand notice to a purchase order), claim 16 (e.g., using a probability specified in an advance demand notice), or claim 17 (e.g., using sourcing options specified by a customer). Accordingly, it is respectfully submitted that that at least these dependent claims must also be found to be allowable.

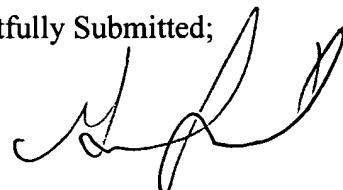
It is further respectfully submitted that the rejection of the claims fails to meet the burdens associated with presenting a *prima facie* case of obviousness for the reason that the rejection of the claims never sets forth any reasoned explanation as to why or how one of ordinary skill in the art would have used the *general* teachings of Yang to modify Abdel-Malek to arrive at the invention that is *specifically* set forth in the claims. In particular, it is respectfully submitted that it is not evident nor has it been explained why or how modifying Abdel-Malek “to include the network of intelligent software agents in order to fulfill service parts between one or more customer locations” would lead one of skill in the art to modify Abdel-Malek to include the aforementioned, expressly claimed element in which intelligent software agents specifically move items to plural locations within a supply chain “as a function of a probability that one or more items specified in an advance demand notice will be needed to be used during performance of a scheduled maintenance work order.”

While this deficiency alone is enough to demonstrate that the rejection of the claims fails to establish a *prima facie* case of obviousness and that the rejection of the claims under 35 U.S.C. § 103 should be withdrawn, it is nevertheless respectfully submitted that, when Yang is considered in its entirety as is required, Yang simply fails to expressly suggest the desirability of modifying Abdel-Malek to arrive at the invention that is specifically claimed. As discussed above, Yang discloses the desirability of using a long term forecast to anticipate needs for parts to thereby establish inventory thresholds at various nodes within a supply chain in hopes of

avoiding excess inventories of certain parts and no availability of others before even a suggestion of a specific need for a part exists. Thus, rather than suggest modifying Abdul-Malek to arrive at the invention claimed, Yang, at most, describes nothing more than a method for establishing the predetermined inventory threshold levels used by Abdel-Malek. While the disclosure within Yang might therefore be said to *supplement* the disclosure within Abdel-Malek, it is evident that nothing from Yang can be said to suggest *modifying* Abdel-Malek to arrive at a system such as the one claimed, namely, one that actively functions to move items within the supply chain in response to a work order/scheduled maintenance activity being entered into a customer maintenance system with the items being moved to locations within the supply chain as a function of a probability that the items will be needed for use in the maintenance activity.

From the foregoing, it is respectfully submitted that, when Abdel-Malek and Yang are considered in their entirety it is evident that neither Abdel-Malek nor Yang , whether considered alone or in combination, can be said to have any disclosure that would lead one of ordinary skill in the art to arrive at the invention claimed, particularly considering ALL of the claims. Thus, it is respectfully submitted that the combination of Abdel-Malek and Yang cannot support a *prima facie* case of obviousness and the rejection of the claims must be withdrawn.

Respectfully Submitted;



By: Gary R. Jarosik
Reg. No. 35,906
Greenberg Traurig, LLP
77 West Wacker Drive, Suite 2500
(312) 456-8449

Date: June 16, 2006